

REMARKS

The Office Action dated November 11, 2005 has been carefully considered. Responsive thereto, Applicant has amended the application as indicated above, and requests that the Examiner consider the following remarks.

The informal drawings have been accepted for examination purposes. The drawings were objected to for informal matters. The abstract of the disclosure was objected to for exceeding the required length. Claims 1, 5, 10, and 14 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Design Patent Number Des. 162,870 to Pearce. Claims 2 – 3 and 11 – 12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Pearce in view of U.S. Patent No. 6,298,580 to Tadayon. Claims 4 and 13 were rejected under 35 U.S.C. 103(a) as being unpatentable over Pearce in view of U.S. Patent No. 4,877,018 to Ikebe et al. Finally, claims 6 – 9 and 15 – 18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Pearce in view of U.S. Patent Application No. 2005/0034355 to Shows.

Responsive to the drawing objections, informal corrected replacement drawing sheets are being filed herewith.

Responsive to the objection to the abstract of the disclosure, a revised abstract that overcomes the objections is being filed herewith.

The claims have been amended to a scope that is considered to be allowable in view of the issues raised by the Examiner in the Office Action. No new matter has been added. Reconsideration is respectfully requested.

Applicant has amended the claims to more clearly define the invention while distinguishing the invention from the cited art. More particularly, the present invention comprises a shoe insert with toe dividers to be worn by a patient, such as a diabetic, to protect

the foot and primarily the toes from abrasion thereby preventing sores. The insert is shaped to conform to the user's foot with the toe dividers providing a soft barrier between the user's toes with rearwardly projecting thin flaps or tabs protecting the top of the user's foot. The present invention thus provides an insert that provides cushioned contact with various parts of the user's foot thereby preventing the formation of sores. The claims have been amended to more particularly point out these structural and functional features. More particularly, claim 10 has been amended to point out that the sole plate, dividers, and covering tabs, are all cushioned. In addition, claim 10 has been amended to more clearly define the structure of the cushioned tabs as being thin in order to cover at least a portion of the top of the foot thereby permitting the user to wear a conventional shoe.

U.S. Patent No. Des. 162,870 issued to Pearce, discloses a pedicure apparatus that significantly distinguishable from the presently claimed invention. Specifically, the Pearce invention, is not shaped to conform to the entire bottom of the foot as is Applicant's invention. More particularly, the Pearce apparatus fails to project to the heel of the foot. In fact, the apparatus disclosed by Pearce not only fails to cover the entire foot, but also does not conform. See, FIG. 4, wherein the front portion of the apparatus is raised and stepped so as to position the toes into a vertically stepped configuration. Further, the Examiner cites Pearce for disclosing rearwardly projecting flaps. Applicant notes however, that the flaps disclosed by Pearce have a relatively large vertical profile and small width (See, FIG. 5), and thus would neither provide protective cover to the top of the foot nor allow the user wear a conventional shoe as does Applicant's presently claimed invention.

U.S. Patent No. 6,298,580, issued to Tadayon, discloses pedicure sandals that includes a sole portion incorporating a toe dividing structure. The dividers disclosed by Tadayon, however,

are relatively wide, so as to “separate the user’s toes such that the likelihood of damage to nail polish applied is minimized.” See, Col. 3, lines 52. –54. Tadayon thus teaches away from Applicant’s thin width dividers that are intended to maintain the toes in closely spaced relation. Tadayon further fails to either teach or suggest rearwardly projecting flaps for covering the top of the foot as disclosed and claimed in the present invention.

U.S. Patent No. 4,877,018, issued to Ikebe et al., discloses rod-like shaped devices for deodorizing and drying portions between the toes. See, Col. 3, line 20 – 22. The Ikebe reference is merely cited for the providing of medicated powders and provides no teaching of incorporating same into an apparatus as claimed by Applicant.

Finally, Patent Application Publication No. US 2005/0034335 to Shows discloses articles for providing foot pain-relief, primarily removable inserts for foot wear. Shows fails to either teach or suggest combining the insert with a toe dividing structure as disclosed by Applicant.

Not only does the cited art fail to teach or suggest the presently claimed invention, either alone or in the combinations suggested by the Examiner, but Applicant is also unable to find any teachings or suggestions that it would be desirable to combine the references as suggested by the Examiner. It is axiomatic that in order to justify combination of references it is not only necessary that it be physically possible to combine them, but that the art contain something to suggest the desirability of doing so. Ex parte Walker, 135 U.S.P.Q. 195 (1961). Furthermore, the Examiner must identify where the prior art provides a motivating suggestion for the combination. In re Jones, 958 F.2d 347, 21 USPQ.2d 1941 (Fed. Cir. 1992). The Federal Circuit, in In re Jones, confirmed that “[b]efore the PTO may combine the disclosures of two or more prior art references in order to establish prima facie obviousness, there must be some suggestion for doing so . . .” (citing In re Fine, 837 F.2d 1071, 1074 (Fed Cir. 1988)).

As discussed above, the various references cited by the Examiner fail to teach or suggest the presently claimed invention, either alone or in combination. In addition, the cited references fail to teach or suggest the desirability of the combined teachings relied on by the Examiner. Accordingly, the proposed combinations are improper and fail to support rejection under 35 U.S.C. § 103. See, C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 48 USPTQ.2d 1225 (Fed. Cir. 1998) (There must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination).

It is improper to use the inventor's disclosure as an instruction book on how to reconstruct the prior art. Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1 USPQ.2d 1593 (Fed. Cir. 1987). During prosecution, an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1 USPQ.2d 1593 (Fed. Cir. 1987) (A holding that claims are invalid based merely upon finding similar elements in separate prior art patents would be contrary to statute and would defeat the congressional purpose in enacting Title 35). As the Federal Circuit has often stated, "virtually all [inventions] are combinations of old elements." Environmental Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698 (Fed. Cir. 1983).

Accordingly, to prevent the use of hindsight based on the invention to defeat patentability of the invention, the law requires the examiner to show a motivation to combine the references that create the case of obviousness. In Re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998). The showing must be clear and particular. Broad conclusory statements regarding the teaching of multiple references, standing alone, is not evidence.

The Federal Circuit has identified three possible sources for a motivation to combine references: (1) the nature of the problem to be solved; (2) the teachings of the prior art; and (3) the knowledge of persons of ordinary skill in the art. Id. In the present case the Examiner relies upon none of the three possible sources for motivation. Instead, after each citation of a particular feature in the cited art, the Examiner summarily concludes that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of X by combining Y.” The Examiner has not, however, explained what specific understanding or technological principal within the knowledge of one of ordinary skill in the art would have suggested the combination. When the Examiner does not explain the specific understanding or principle within the knowledge of a skilled artisan that would motivate one with no knowledge of the present invention to make the combination, it is presumed that the Examiner selected the references with the assistance of hindsight. Id. at page 1358.

While a suggestion to combine may come from the prior art, as filtered through the knowledge of one skilled in the art, Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 43 USPQ.2d 1481 (Fed. Cir. 1997), rarely will the skill in the art operate to supply missing knowledge or prior art to reach an obviousness judgment. In re Rouffet, 149 F.3d 1350, 47 USPQ.2d 1453 (Fed. Cir. 1998). If such rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance. Id.

In Ex Parte Clapp, 227 USPQ 972, claims were rejected under 35 U.S.C. §103 when the Examiner combined a number of references. The Board in Clapp set out the requirement that the Examiner state a line of reasoning as to why the artisan, viewing only the collective teachings of the references, would have found it obvious to selectively pick and choose various elements

and/or concepts from the several references relied on to arrive at the claimed invention. The Board in Clapp noted that the Examiner had done little more than “cite references to show that one or more elements or sub-combinations thereof, when each is viewed in a vacuum, is known. 227 USPQ 972, 973. The Board held that “to support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” 227 USPQ 972, 973. The Board could not find anything in the references to expressly or impliedly teach or suggest the modifications urged by the Examiner, nor could the Board find a line of reasoning advanced by the Examiner as to why the artisan would have concluded that the modifications urged by the Examiner were obvious. The Board held that, on the record before it, “the artisan would not have found it obvious to selectively pick and choose elements or concepts from the various references so as to arrive at the claimed invention without using the claims as a guide.”

Applicants also rely on the decision of the Court of Appeals for the Federal Circuit in Carella v. Starlight Archery, 231 USPQ 644. One of the issues in Carella was the obviousness of the invention over the prior art. The CAFC noted that the Court below had acknowledged that use of vertical height for range finding, use of multiple elements on a sight and use of circular apertures were each known in the art, but concluded that the prior art lacked any teaching or suggestion to combine the separate features in a manner permitting use of circular apertures for simultaneous range finding. Obvious cannot be established by combining the teachings of the prior art to produced the claimed invention absent some teaching, suggestion or incentive

supporting the combination. ACS Hospital Systems, Inc. v. Montefiore Hospital, 723 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984).

Both Carely and Clapp stand for the proposition that the art, not the Examiner, must teach the suggested combination. Further, if the references do not expressly or impliedly suggest the claimed combination then the burden falls on the Examiner to advance a line of reasoning which supports the position advanced by the Examiner.

In Alco Standard Corp. v. Tennessee Valley Authority, 808 F.2d 1490, 1498, 1 USPQ.2d 1337, 1343 (Fed. Cir. 1986), the court stated: "the question is not simply whether the prior art 'teaches' the particular element of the invention, but whether it would suggest the desirability, and thus the obviousness, of making the combination." The record does not reveal any such suggestion or teaching that would lead to the Applicants' claimed invention.

In view of the amendments and arguments presented herein it is believed that that the claims are patentably distinguishable over the prior art. Accordingly, Applicants respectfully requests a favorable action on this case.


Should the Examiner have any questions, comments, or concerns, the undersigned would appreciate a telephone conference in order to expedite this case.

Respectfully submitted,

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IN THE DRAWINGS

Kindly substitute the amended replacement drawing sheets submitted herewith (Figs. 4, 5, 12, 13, and 16) for the sheets of record.

IN THE ABSTRACT OF THE DISCLOSURE

Kindly substitute the revised abstract submitted herewith for the abstract of record.